



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,863	11/06/2001	Emmet Joseph Howard Peter Andrews	1817-0116P	4454

7590

04/25/2003

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

ROBERTS, PAUL A

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 04/25/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,863

Applicant(s)

MANDROS

Examiner

Paul A Roberts

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/06/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 46 is objected to because of the following informalities: intercostal is spelled wrong. Appropriate correction is required.
2. Please check the claims for improper spacing between words such as the word 'hand les' in claim 77, line 5.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the connector (claims 1-76, 85-87) and the tubing gripper (claims 77-84) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the guide blade having the same length as the curved blades (claims 16, 39, 53, 75, & 83) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Looking at figure 1, item 5 is the guide blade, it clearly does not have the same length as item 2, the curved blades.
5. Claims 21 and 57 are also rejected under 35 U.S.C. 112 second paragraph because these claims claim subject matter contrary to the illustrations. The intercostal drain item 11, figure 3 appears to be below the blades. Also the blades (2), do not extend past or above the guide blade (5.)

Art Unit: 3731

6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the applicant only discloses bifurcated arms in the specification. The applicant has claimed the limitation “arms.” “Arms” are not related to “bifurcated arms.” Thus, the recitation of arms in all the claims containing the phrase, “arms”, fails to have proper antecedent basis in specification. Further, there is no reference number for any type of arms other than bifurcated arms in the specification or diagrams. Further, in claims reciting arms, it is unclear whether applicant is referring to item 7 or the unlabeled item between 6 and 8. Applicant should amend claims to give a name to the other arms to differentiate them from the bifurcated arms and use that term consistently. A term such as “forcep arm” would be sufficient.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5, 8, 10, 11-23, 27, 29-46, 47-59, 64, 69, 70-76, 77-84, & 85-87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no

Art Unit: 3731

‘third’ guide blade unless there is a first and second guide blade. Applicant should remove the limitation ‘third’, since the other blades are not referred to as guide blades.

9. Claims 21 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21 and 44 recite the limitation "the intercostal drain" in line 3. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The guide blade is not between the pivot joint. The figures show the guide blade being inside the pivot joint.

11. Claim 77, lines 7-10 contains unintelligible grammar rendering the scope of the claim unascertainable. Specifically, the phrase “each arm of which carries a tubing gripper and arcuate shape which can be urged apart...” is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 10, 11, 12, 13, 14, 15, 16, 17, 19, 20, 23, 35, 37, 38, 39, 40, 42, 43, 46, 48, 51, 52, 53, 54, 55, 56, 59, 60, 65, 67, 70, 71, 72, 73, 74, 75, 76, 77, 78, 81, 82, 83, 84, 85, & 86

are rejected under 35 U.S.C. 102(b) as being anticipated by Boughten et al. "Boughten" US 5,014,407.

12. Regarding claims 1, 60, & 70, Boughten teaches a scissors-type forceps with a pair of arms (12 14) and a pivot joint (24). The arms cross in the center of the tool (near item 24). Each arm is on one side of the pivot joint and comprises a blade (18a and 18b). It is unclear what a connector is, since the applicant failed to describe or illustrate the connector. The examiner assumes item 30 is connector, since it connects item 28 to item 26. A third guide blade is shown as 18c. The guide blade is rectangular.

13. Regarding claims 8, 10, 11, 12, 35, 71, & 81, the third blade is mounted to the pivot joint. This blade is below the other two blades, when the tool is held upright with the blades extending towards the user.

14. Regarding claims 13, 72, & 82, figure 6b shows that 18c is between 18b and 18a. Thus the third guide blade is between the other two blades.

15. Regarding claims 14, 20, 23, 37, 43, 46, 51, 56, 59, 65, 67, & 73, handles 20 and 22, are a releasable grip means. The user grips the handles and can release them. The Boughten tool can be used to carry a tube or drain. The arms cross intermediate their ends at 24.

16. Regarding claims 15, 38, 52, & 74 the guide blade extends away from the pivot joint forwardly and rearwardly.

17. Regarding claims 16, 75, & 83, the guide blade extends the same distance as the other blades.

18. Regarding claims 17, 40, 48, 54, 76, & 84, the guide blade is flat, tapers towards its free end and carries a pivot pin (25) to form the pivot joint. The pivot pin limitation is unclear

Art Unit: 3731

because the applicant has not described the pivot pin nor illustrated it in the drawings.

Consequently, the examiner must assume item 25 is a pivot pin, since it's a pin in the pivot of the Boughten device.

19. Regarding claims 19, 42, & 55, figure 6c shows blades 18b and 18a sandwiching blade 18c. Note that blade 18c includes 16, 18b includes 34, and 18a includes 32.

20. Regarding claim 35, the guide blade is below the blades and above the pivot joint, thus it is between the blades and the pivot joint.

21. Regarding claims 39 & 53, the guide blade and the blades extend approximately the same distance.

22. Regarding claims 77, 78, and 85-86, since the applicant has not described or illustrated a tube gripper, the structure of a tube gripper is not well understood. As best understood, the tubing grippers are the items 18a-c on the Boughten device. The blade members are items 34, 16, and 32. The guide blade terminates in a bifurcated (28 and 26) portion. Each arm (14 and 12) carries a tubing gripper (18a and 18b.) The tubing gripper has an arcuate shape figure 6b. The arms cross intermediate their ends at 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 4, 5, 7, 9, 18, 22, 24, 25, 26, 27, 28, 30, 31, 32, 33, 34, 41, 45, 47, 48, 49, 50, 58, 61, 62, 63, 64, 66, 67, 68, 69, 79, 80, 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boughten et al '407 in view of Redmon US 5,569,300.

23. Regarding claims 2, 24, 47, 61, & 64, the Boughten device discloses all of claim 1, but does not disclose arcuate blades with mouths facing one another. Redmon teaches making the blades of an antipodal forceps arcuate and open mouthed for the purpose of fitting an illuminator between the blades as shown in figure 1. It would have been obvious to one of ordinary skill at the time of the invention to add the illuminator of the Redmon device to the Boughten device to provide a light source to aid the operator's vision during utilization of the Boughten device. It would also have obvious to one of ordinary skill at the time of the invention to make the Boughten blades arcuate and open-mouthed as demonstrated by Redmon because making this modification would allow the illuminator to fit into the forceps blade and thereby allow the forceps to close completely.

24. Regarding claims 3, 6, 25, 32, 48, 62, & 67, the Boughten device has tapering blades.

Claims 4, 5, 7, 9, 18, 22, 26, 27, 28, 30, 31, 33, 34, 41, 45, 49, 50, 58, 63, 66, 68, 69, 79, 80, & 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined Boughten device in view of Redmon US '300.

25. Regarding claims 4, 7, 9, 22, 26, 28, 33, 34, 45, 49, 50, 58 63, 68 69, 79, 80, & 87, the Boughten device discloses all of claim 3, but does not disclose spring-urged handles. It is well known in the art to use a spring to urge handles open such as illustrated in figure 1 of Redmon 5569300. The motivation to add spring-urged handles to the Boughten device is to allow the device to return the blades closed position automatically. At the time of the invention it would

Art Unit: 3731

have been obvious to one of ordinary skill in the art to add the Redmon spring-urged handles to the Boughten device for the purpose of automating the closing of the blades.

26. Regarding claims 5, 18, 27, 29, 30, 31, and 41 a third guide blade is shown as 18c. The guide blade is rectangular.

Double Patenting

27. Many of the claims are objected to under 37 CFR 1.75 as being a substantial duplicate of another claim. For example, claim 2 is a duplicate of claim 24. Applicant should remove this and all other duplicate claims in the application. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

D262,055	antipodal forceps.
5690606	tissue expander
5997474	specula
5865075	antipodal forceps
5826467	antipodal forceps
5522839	gun grip antipodal forceps


Art Unit: 3731


5065650	antipodal forceps
5415664	stent introducer
6436117	gun grip anti-podal forceps
5855590	forceps with introducer
5456695	multi-tool device
5683349	antipodal resector

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Paul Roberts
April 21, 2003


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700